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31955	7590	07/12/2004	EXAMINER	
CAPSTONE LAW GROUP LLP 1810 GATEWAY DRIVE SUITE 260 SAN MATEO, CA 94404			HAYES, JOHN W	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/716,637

Applicant(s)

COOPER, JONATHAN D.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 59-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/18/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of Claims*

1. Applicant has canceled claims 1-58 and added new claims 59-75 in a preliminary amendment filed 18 November 2003. Thus, claims 59-75 are the only claims pending.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 67 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 recites the limitation "said secure money transfer instrument" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 59 and 68-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Brody et al, U.S. Patent No. 5,350,906.

As per **Claim 59**, Brody et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40; Col. 9, lines 44-53; Col. 10, lines 8-24);

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- receiving information associated with a recipient for said secure money transfer (Col. 3, lines 12-19; Col. 11, lines 40-50);
- receiving information indicating an amount of said secure money transfer (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40);
- transferring said amount to a secure money transfer instrument (Col. 3, lines 20-28; Col. 13, lines 44-56; Col. 13 line 67-Col. 14 line 10);
- assigning an access code to said secure transfer instrument (Col. 3, lines 5-20; Col. 6, lines 45-53; Col. 14, lines 1-10);
- providing said secure money transfer instrument to said recipient (Col. 3, lines 20-37; Col. 6, lines 64-67; Col. 14, lines 1-10); and
- providing said access code from said requestor to said recipient (Col. 3, lines 20-22; Col. 6, lines 60-65);
- wherein said secure money transfer instrument is a card for use in automated teller machines (Col. 3, lines 5-37; Col. 5, lines 47-53; Col. 6, lines 25-30; Col. 7, lines 9-30); and
- whereby said secure money transfer instrument and said access code enable said recipient to use said secure money transfer instrument in said automated teller machines (Col. 3, lines 20-37; Col. 6, lines 25-30; Col. 7, lines 9-30).

As per Claim 68, Brody et al disclose an automatic money transfer system for transferring money from a donor to a donee comprising:

- an automated server system for facilitating the secure transfer of money from a donor to a donee (Figure 1; Col. 6 line 7-Col. 7 line 30), said automated server system being operative to allocate funds to a portable secure transfer instrument (Col. 3, lines 20-28; Col. 13, lines 44-56; Col. 13 line 67-Col. 14 line 10) and to assign a security code to said instrument (Col. 3, lines 5-20; Col. 6, lines 45-53; Col. 14, lines 1-10), said secure transfer instrument including machine readable information (Col. 5, lines 5-20; Col. 6 line 60-Col 7 line10);

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- a data storage device for recording said secure transfer (Col. 7, lines 14-24 and 33-43; Col. 8 line 64-Col. 9 line 40); and

- a delivery system for providing said portable secure transfer instrument to said donee (Col. 3, lines 20-37; Col. 6, lines 64-67; Col. 14, lines 1-10 ) enabling said donee to access said funds from an automated teller machine using said portable secure transfer instrument and said security code (Col. 3, lines 20-37; Col. 6, lines 25-30; Col. 7, lines 9-30);

- wherein said donor provides the security code to the donee (Col. 3, lines 20-22; Col. 6, lines 60-65).

As per **Claim 69**, Brody et al further disclose wherein the security code is contained in the machine readable information (Col. 5, lines 5-20; Col. 6 line 60-Col 7 line10).

As per **Claim 70**, Brody et al further disclose wherein the security code must be manually entered on the atm by the donee in order for the donee to receive money (Col. 7, lines 14-20).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 60 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Ito et al, U.S. Patent No. 6,039,250.

As per **Claims 60 and 71**, Brody et al fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the

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requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this were well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

8. Claims 61, 72-73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Picciallo, U.S. Patent No. 6,044,360.

As per **Claims 61 and 72**, Brody et al further disclose receiving information including a delivery address personal to the recipient (Col. 11, lines 40-50), however, fails to disclose providing the secure money transfer instrument to the recipient at the delivery address personal to the recipient. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and incorporate the ability to delivering the computer readable medium directly to either the sender or the recipient at a particular address as taught by Picciallo, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender.

As per **Claim 73**, Brody et al disclose an automated process for sending money from a first location to a second location comprising:

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- receiving a request for a secure money transfer from a requestor (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40; Col. 9, lines 44-53; Col. 10, lines 8-24);
- receiving information associated with a recipient for said secure money transfer (Col. 3, lines 12-19; Col. 11, lines 40-50);
- receiving information indicating an amount of said secure money transfer (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40);
- transferring said amount to a secure money transfer instrument (Col. 3, lines 20-28; Col. 13, lines 44-56; Col. 13 line 67-Col. 14 line 10);
- assigning an access code to said secure transfer instrument (Col. 3, lines 5-20; Col. 6, lines 45-53; Col. 14, lines 1-10);
- providing said secure money transfer instrument to said recipient (Col. 3, lines 20-37; Col. 6, lines 64-67; Col. 14, lines 1-10); and
- providing said access code from said requestor to said recipient (Col. 3, lines 20-22; Col. 6, lines 60-65);
- wherein said secure money transfer instrument is a card for use in automated teller machines (Col. 3, lines 5-37; Col. 5, lines 47-53; Col. 6, lines 25-30; Col. 7, lines 9-30); and
- whereby said secure money transfer instrument and said access code enable said recipient to use said secure money transfer instrument in said automated teller machines (Col. 3, lines 20-37; Col. 6, lines 25-30; Col. 7, lines 9-30).

Brody et al fail to disclose providing the secure money transfer instrument to the recipient at the delivery address personal to the recipient. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and incorporate the ability to delivering the computer readable medium directly to

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either the sender or the recipient at a particular address as taught by Picciallo, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender.

As per Claim 75, Brody et al further disclose wherein the access code is provided to the recipient by the sender (Col. 3, lines 20-22; Col. 6, lines 60-65).

9. Claims 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Corder et al, U.S. Patent No. 5,936,221.

As per Claim 62, Brody et al disclose wherein the secure money transfer is used to transfer money from the requestor located in a first country to a recipient located in a second country (Col. 7, lines 9-14 and 44-48; Col. 8, lines 7-12 and 20-28). Brody et al, however, fail to disclose that the requestor may allocate additional money to the secure money transfer instrument via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per Claim 63, Brody et al further disclose wherein the amount is provided by the requester in a first currency and provided to the recipient in second currency, wherein the first currency and the second currency are of different nationalities (Col. 8, lines 20-29).

10. Claims 64-66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Picciallo, U.S. Patent No. 6,044,360 and Corder et al, U.S. Patent No. 5,936,221



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As per Claims 64-66, Brody et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40; Col. 9, lines 44-53; Col. 10, lines 8-24), indicating a destination for the transfer (Col. 3, lines 12-19; Col. 11, lines 40-50) and an amount for transfer via a communications network such as the atm network (Col. 2, lines 43-56; Col. 6, lines 16-25 and 35-40);
- assigning said amount to an atm card (Col. 3, lines 20-28; Col. 13, lines 44-56; Col. 13 line 67- Col. 14 line 10);
- assigning an access code to said atm card (Col. 3, lines 5-20; Col. 6, lines 45-53; Col. 14, lines 1-10);
- providing said access code from said requestor to said recipient (Col. 3, lines 20-22; Col. 6, lines 60-65);
- providing the atm card to the destination such that a recipient receives the atm card enabling said recipient to withdraw funds from an atm using the atm card and the access code (Col. 3, lines 20-37; Col. 6, lines 25-30; Col. 7, lines 9-30).

Brody et al discloses that there are two different cards used however. The recipient receives a withdrawal atm card at a retail outlet wherein the withdrawal card is a different card than the one the sender used to send the funds. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and incorporate the ability to delivering the configured atm card directly to either the sender or the recipient at a particular address as taught by Picciallo, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender.

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Brody et al further fail to explicitly disclose that the requestor submit additional requests for allocating additional money to the atm card via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

11. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Picciallo, U.S. Patent No. 6,044,360 and Corder et al, U.S. Patent No. 5,936,221 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

As per Claim 67, Brody et al fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this were well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

12. Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent No. 5,350,906 in view of Picciallo, U.S. Patent No. 6,044,360 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

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As per **Claim 74**, Brody et al fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this were well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

### **Conclusion**

13. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Marcous et al discloses many features of applicant's invention, however, without the need to have a card to activate the dispensing terminal
- Stoutenburg et al disclose a method for performing money transfers through a TCP/IP network including establishing a desired amount to be transferred, establishing a code that corresponds to the transaction details and transmitting the code from the sender to the recipient

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- Rizzo et al disclose a method for cash transfers that allows an originator to set up a transaction using a telephone or website and transfer money to a recipient who uses an ATM card to receive the funds
- Downing et al disclose a method for transferring funds from an account to an individual and teach that an originator can transfer an amount to a cash access file which can be accessed 24 hours a day wherein access is achieved by the recipient entering a codeword selected by the sender along with a transaction code and wherein the recipient can receive funds through an ATM even without using a card to access the system.
- Ito et al disclose a method of transferring funds from a sender to a receiver using a communications network and e-mail.
- Farris et al disclose a method for transferring funds from a customer to a patron by depositing cash into a kiosk, providing a security code to the customer who then provides this code to a patron who inputs the code into a kiosk in order to receive the funds.
- Cucinotta et al disclose a method for holding and dispensing cash upon demand at a remote location
- Jennings et al disclose a method for transferring funds by allowing funds to be transferred instantly to an account so that they are available to a beneficiary
- Davis et al disclose a method for activating cards at the point of distribution.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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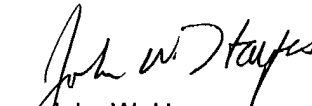
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

  
John W. Hayes  
Primary Examiner  
Art Unit 3621

July 8, 2004